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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : **Confirmation No. 9098**
Hiroaki MASUYAMA et al. : Attorney Docket No. 2006_0607A
Serial No. 10/577,038 : Group Art Unit No. 3693
Filed April 24, 2006 : Examiner Edward J. Baird

ENTERPRISE EVALUATION DEVICE
AND ENTERPRISE EVALUATION
PROGRAM : **Mail Stop Amendment**

RESPONSE TO SECOND RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

THE COMMISSIONER IS AUTHORIZED
TO CHARGE ANY DEFICIENCY IN THE
FEES FOR THIS PAPER TO DEPOSIT
ACCOUNT NO. 23-0975

Sir:

Pursuant to the restriction set forth in the Office Action mailed September 23, 2008, the Applicants hereby elect invention I, claims 1, 2 and 4, with traverse.

In the Office Action, the Examiner acknowledged that the present application is a national stage application under 35 U.S.C. § 371 that is subject to unity of invention standards, not U.S. restriction practice pursuant to 37 CFR 1.141 - 1.146. Accordingly, when making a lack of unity of invention requirement, the Examiner **MUST** (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group (see MPEP § 1893.03(d)). However, the Examiner has not explained “why there is no single general inventive concept” specifically describing “the unique special technical feature in each group” (see MPEP § 1893.03(d)).

Instead, the Examiner asserted that “the subcombinations are distinct if they do not overlap in scope and are not obvious variants” (see item 10 on page 4 of the Office Action). However, by doing so the Examiner has applied U.S. restriction practice pursuant to 37 CFR

1.141 - 1.146, which, as noted above, is improper for national stage applications under 35 U.S.C. § 371. Moreover, unity of invention, as detailed in MPEP § 1893.03(d), cannot be denied because claims form subcombinations, are not overlapping in scope, or are not obvious variants.


In the Office Action, the Examiner also attempted to identify separate technical features for each of the inventions I-XI listed therein. Specifically, the Examiner asserted that "Invention I has separate utility such as a device for acquiring an operating profit" (see item 11 on page 4 of the Office Action). Thus, the Examiner identified "acquiring an operating profit" as the special technical feature of Invention I. However, because claims 7, 9, 13, 15, 21, 23, 26, 28, 34, 36, 39, 41, 45, 47, 53, 55, 58 and 60 each acquire an operating profit, they should also be included in Invention I. Consequently, the Applicants respectfully submit that the Examiner has failed to properly describe "the unique special technical feature in each group."

For at least the reasons set forth above, the Applicants respectfully request withdrawal of the restriction and a full examination on the merits of all of the claims in the present application.

If there are any issues that the Examiner feels may best be resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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